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10/711,481

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James W. Taylor

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05/16/2008

BASF AG

CARL-BOSCH-STRASSE 38

6700 LUDWIGSHAFEN

RHEINLAND-PFATZ D-67056, 67056

GERMANY

EXAMINER

YOON, TAE H

ART UNIT

PAPER NUMBER

1796

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/711,481 | Applicant(s) TAYLOR ET AL. | |
| | Examiner Tae H. Yoon | Art Unit 1796 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20, 22 and 23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8, 20, 21 and 25-28 of copending Application No. 11/230,114 (US Pub. 2006/0063868). Although the conflicting claims are not identical, they are not patentably distinct from each other because an amount of a stabilizing agent in said copending application encompasses that of the instant invention and since use of a nonionic surfactant would be an obvious modification to one skilled in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Rejection is maintained since claims are not allowable.

A recitation of “or” after “biocides” in line 4 of claim 20 is suggested.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 4, 11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Amended claim 1 now recites a water-borne polymer comprising carboxylate groups, but many species of polymers in said claims 3 and 4 do not contain said carboxylate groups. Also, the recited “hybrid thereof” and “blend thereof” are also indefinite in view of the amendment with respect to the nature of any polymeric component therein. Thus, claims are confusing and indefinite. Cancellation of non-carboxylated polymers is needed. The recited “the water-borne polymer comprises carboxylate groups” in claim 11 is redundant. A salt of claim 14 improperly broadens scope of claim 13.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-13 and 16-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wickert et al (US 6,214,450).

Wickert et al teach the instant compositions at cols. 4, 7 and 8 and in table VIII which inherently meet the instant stability since they are coating (paint) composition requiring a shelf-life. Amounts of AZC and propylene glycol inherently meet the instant extra mole percent, and ammonium carbonate in AZC meets the instant buffering agent also..

Thus, the invention lacks novelty.

Claims 1-5, 7-13 and 16-23 are rejected under 35 U.S.C. 103(a) as obvious over Wickert et al (US 6,214,450).

Claim 5 recites acrylic/styrene polymer over Wickert et al, but Wickert et al teach various monomers such as acrylate and styrene and copolymers thereof at col. 6, lines 1-6.

Thus, it would have been obvious to one skilled in the art at the time of invention to utilize acrylic/styrene copolymer in Wickert et al since Wickert et al teach such modification absent showing otherwise.

Claims 1-13 and 16-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gower et al (US 3,647,732).

Gower et al teach various film forming polymers containing carboxylated groups such as styrene/acrylic acid copolymer at col. 2, lines 20-52. Examples IV and VII show use of ethylene glycol and AZC or zinc oxide. Ammonium carbonate in footnote f for example VII meets the buffering agent. Amounts of ethylene glycol and zirconium in AZC in said example IV would meet the instant excess glycol inherently.

Gower et al recite US 3,320,196 and US 3,308,078 being incorporated by reference. Rogers (col. 14) and Rogers et al (col. 14 and table III) teach the instant acid number and styrene/acrylic acid copolymer. The compositions of Gower et al would meet the instant stability since they are coating (paint) composition requiring a shelf-life.

Thus, the invention lacks novelty.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as obvious over Gower et al (US 3,647,732) and Rogers (US 3,320,196) and Rogers et al (US 3,308,078) incorporated by reference at col. 2, lines 50-52, and in view of GB 1 337 983..

The instant invention further recites acids and sugar over Gower et al.

However, Gower et al also teach employing fatty acids as stabilizers for zirconium at col. 6, lines 48-63.

GB teaches the instant acids and sugar and their use in stabilizing AZC.

It would have been obvious to one skilled in the art at the time of invention to utilize the acid or sugar of GB in Gower et al since Gower et al teach employing fatty

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acids and since use of the instant fatty acid in stabilizing AZC is well known as taught by GB and further to use sugar of GB in Gower et al since Gower et al teach stabilization of AZC composition and thus use of known AZC stabilizer would be obvious absent showing otherwise.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tae H Yoon
Primary Examiner
Art Unit 1796

THY/May 13, 2008

/Tae H Yoon/